

## REMARKS

In response to the Office Action dated 25 February 2003, claim 11 has been canceled without prejudice or disclaimer and claims 1, 3, 8, 18 and 19 have been amended. Claims 1-10 and 12-21 are currently pending in the application. No new matter has been added. Reconsideration of the claims is respectfully requested.

In paragraph 3 on page 2 of the Office Action, claims 1-9, 11-12 and 14-21 were rejected under 35 U.S.C. §102 (b) as being anticipated by US 5,813,607 (Waggoner). The Applicant respectfully traverses the rejections, however to advance prosecution in the application claim 11 has been canceled and claims 1, 3, 8, 18 and 19 have been amended.

To anticipate a claim, a reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their limitations, must be found in the reference to maintain a rejection based on 35 U.S.C. § 102. The Applicant respectfully submits that Waggoner does not teach every element of independent claims 1, 8, 14, and 18, in view of the amendments made to claims 1, 8 and 18, and therefore fails to anticipate claims 1, 8, 14 and 18.

The Applicant sets forth in independent claims 1, 8, 14, and 18, among all the other features of the instant invention, a backing member separated by a split-line.

In paragraph 3, the Office Action identified a backing member 12 in Waggoner. A few lines later the Office Action suggests that the die-cut lines provide for the split-lines to form a first and second section. The Applicant respectfully disagrees and respectfully points out that the die cut lines in Waggoner are found in the opaque member 14 and the transparent film 10, only. There are no split-lines or die-cut lines in the backing member 12 in Waggoner.

The Applicant's invention as set forth in independent claims 1, 8, 14, and 18, claims 1, 8 and 18 being amended, is different from Waggoner at least because

Waggoner merely teaches die-cut lines in the opaque member 14 and the transparent member 10, and not in the backing member 12, whereas the Applicant set forth a backing member separated by a split-line.

The split-line in the backing member of Applicant's claimed invention is significant because the split-line facilitates the method of application of the label member and the laminate member when applying those members to a folder as set forth in the specification. The Applicant respectfully requests that rejections of the independent claim be immediately withdrawn and the application passed to issue.

Dependent claims 2-7, 9, 12, 15-17 and 19-21, which are dependent from independent claims 1, 8, 14, and 18, were also rejected under 35 U.S.C. § 102(b) as being unpatentable over Waggoner. While the Applicant does not acquiesce to the particular rejections to these dependent claims, it is respectfully asserted that these rejections are moot in view of the remarks made in connection with independent claims 1, 8, 14 and 18. These dependent claims include all of the features of the base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited reference. Therefore, dependent claims 2-7, 9, 12, 15-17 and 19-21 are also in condition for allowance. The Applicant respectfully requests that the rejections be withdrawn and the application passed to issue.

In paragraph 5 on page 3 of the Office Action, claims 1-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Waggoner. The Applicant respectfully traverses the rejections.

Three criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference, or combination of references, must teach or suggest all the claim limitations. MPEP § 2142. The Applicant respectfully traverses the rejection because the cited reference fails to disclose all the claim features.

The Applicant's invention as set forth in independent claims 1, 8, 14, and 18, claims 1, 8 and 18 being amended, is different from Waggoner at least because Waggoner merely teaches die-cut lines in the opaque member 14 and the transparent

member 10, and not in the backing member 12, whereas the Applicant set forth a backing member separated by a split-line. The split-line in the backing member of Applicant's claimed invention is significant because the split-line facilitates the method of application of the label member and the laminate member when applying those members to a folder as set forth in the specification.

Further, it would not be obvious to the ordinarily skilled artisan to modify the laminated structure of Waggoner to provide the backing member with a split-line as taught by the Applicant, because Waggoner does not teach or suggest a need for the split-line to perform any function whereas the Applicant's method of application of the label and laminate establish the split-line as a significant feature of the Applicant's claimed invention.

The Applicant respectfully requests that rejections of the independent claims be immediately withdrawn and the application passed to issue.

Dependent claims 2-7, 9, 10, 12, 13, 15-17 and 19-21, which are dependent from independent claims 1, 8, 14, and 18, were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Waggoner. While the Applicant does not acquiesce to the particular rejections to these dependent claims, it is respectfully asserted that these rejections are moot in view of the remarks made in connection with independent claims 1, 8, 14 and 18. These dependent claims include all of the features of the base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited reference. Therefore, dependent claims 2-7, 9, 10, 12, 13, 15-17 and 19-21 are also in condition for allowance. The Applicant respectfully requests that the rejections be withdrawn and the application passed to issue.

In view of the amendments and reasons provided above, it is respectfully asserted that all pending claims are in condition for allowance. The Applicant respectfully requests favorable reconsideration and early allowance of all pending claims.

If a telephone conference would be helpful in resolving any issues concerning this communication, please feel free to contact the Applicant's attorney of record, Michael B. Lasky at (952) 253-4106.


Respectfully submitted,

Altera Law Group, LLC



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By:

  
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